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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------------|------------------------|
| 10/812,609 | 03/30/2004 | Paul Re | SCAN-1 CON | 3229 |
| 7590 Mark J. Pandiscio Pandiscio & Pandiscio 470 Totten Pond Road Waltham, MA 02154 | | 07/26/2007 | EXAMINER BACHMAN, LINDSEY MICHELE | |
| | | | ART UNIT 3734 | PAPER NUMBER PAPER |
| | | | MAIL DATE 07/26/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|-----------------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/812,609 | RE ET AL. | |
| | Examiner Lindsey Bachman | Art Unit 3734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 April 2007.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1, 3, 5-9, 11, 12, 16-20 is/are pending in the application.

4a) Of the above claim(s) 5-8, 11, 18 and 19 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 3, 9, 12, 16, 17, 20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application

6) Other: _____

DETAILED ACTION

This Office Action is in response to Applicant's amendment filed on 26 April 2007.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

The correct statement should read: "I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1, 3, 9, 12, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulhauser, et al. (US Patent 6,267,772) and Noiles (US Patent 4,060,089).**

4. Claims 1 and 3: Mulhauser'772 teaches a tissue repair device (10) containing a body containing a frame portion (14) and an integral cover portion (12) disposed within the frame portion (see side view in Figure 2b). Further, the device contains legs (22). Mulhauser'772 teaches that the cover portion can be bowed proximally (column 3, lines 60-61). Mulhauser'772 does not teach that the legs are several times longer than the thickness of the body, nor do the legs contain central channels.

5. Noiles'089 discloses legs (17) for attaching to soft body tissues that are several times longer than the device being attached (see Figures 4 and 5) and contain a central channel (28) and the leg members have pointed end portions. The central channel extends at least to a point that is proximal to the distal end of the leg member (see Figures 4 and 5). Noiles'089 discloses this configuration because the length of the legs allows the legs to be firmly engaged with the tissue and the channel engages with soft body tissues in a precise manner and retains the tissue to the fastener (column 1, lines 5-23). Noiles'089 teaches protrusions (18a, 19a) on each leg for engaging with a retainer strip (13) in order to prevent withdrawal. It would have been obvious to one skilled in the art at the time the invention was made to modify the device taught by

Mulhauser'772 with the legs taught by Noiles'089 because they are longer and capable of engaging the tissue better.

6. Claim 9: Mulhauser'772 teaches attaching the cover to the frame using insert molding (column 4, lines 26-34).

7. Claim 12: Mulhauser'772 teaches a shell member (14) and struts (22) that extend from the center of the shell member (center of outer frame circumference).

8. Claim 16: Mulhauser'772 teaches that the fabric can be made of absorbable material (column 4, lines 35-51). Further, Noiles'089 teaches that his device is made of bioresorbable material because this is desirable for physiological reasons (column 1, lines 1-23).

9. Claim 17: Mulhauser'772 teaches that the cover can be a material which promotes cell growth (column 4, lines 35-51).

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulhauser'772 and Kaikkonen et al. (US Patent 6,533,454).

11. Claim 20: Mulhauser'772 teaches a method of repairing a cartilage defect that includes providing a body for disposition against a bone with a defect in which the device contains elongated leg structures (22) for disposition into the bone and bring the distal surface of the device into contact with the bone (column 7, lines 13-35 and column 3, lines 39-41). Mulhauser'722 teaches that the cover portion can be bowed proximally (column 3, lines 60-61). Mulhauser'772 does not teach that the legs are several times larger than the thickness of the body, nor do the legs contain central channels that extend partially through the legs.

12. Kaikkonen'454 teaches a device for tissue fixation with legs (1) that are several times longer than a plate (6) being attached (see Figure 3) in order to provide several protuberances on the shaft of the leg in order to aid in firmly holding the leg to the bone (column 5, lines 29-44). The device contains a central channel (11) that extends only partially through the leg in order to allow the device to be grasped with a tool. It would have been obvious to one skilled in the art at the time the invention was made to modify the legs taught by Mulhauser'772 with longer legs having a central channel extending partially through so that the device can be applied with a tool member.

Response to Arguments

Applicant's arguments filed 26 April 2007 have been fully considered but they are not persuasive.

Claim 1: Applicant's amendment regarding the concavity of the cover has not overcome the art of record because Mulhauser'722 explicitly states in column 3, lines 60-61 that the device can be formed with slight concavity or convexity. Applicant's amendment regarding the central channel does not overcome the Noiles'089 because the central channel does "extend to a point removed from the distal end of the leg member." Applicant's amendment does not require that the central channel end at a point before the end of the leg member.

Claim 20: Applicant's arguments with respect to claim 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lindsey Bachman whose telephone number is 571-272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ib



LOAN H. THANH
PRIMARY EXAMINER